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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,003	07/28/2000	Kaname Nihei	0905-0242P-SP	3113

2292 7590 04/20/2005

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EXAMINER

GENCO, BRIAN C

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/628,003	Applicant(s) NIHEI, KANAME	
	Examiner Brian C Genco	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's amendment filed January 31, 2005 has overcome the grounds of rejection previously presented.

Applicant argues that Ito fails to teach or suggest capturing data from a visible recording medium.

Examiner notes that Applicant has provided examples of visible recording medium as a photograph, film, etc. on page 5, lines 21-24 of the specification. Examiner notes in particular the etc. It is Examiner's position that a person is a visible recording medium, and in fact anything that a camera can take a picture of is a visible recording medium. In particular a person has recorded on them various features such as scars, facial characteristics, missing limbs, etc. that are visible. Furthermore it is known that people print on themselves in the form of makeup, tattoo's, or even simply writing on themselves with a pen or marker. Similarly anything captured by a camera has certain characteristics recorded on it and as such is a visible recording medium.

Should Applicant's argue that their definition limits the term "visible recording medium" to a photograph or film or other image printed on a document, then Examiner notes that Ito's invention is still "able to capture the image data from ... the visible recording medium". In particular, all that is needed is for a photograph or film or other image printed on a document to be placed in front of the camera.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In regards to claim 1 the claims require among other limitations a system comprising an input/output unit that is able to capture the image data from the portable recording medium and the visible recording medium; a hot-pluggable input/output interface to which the input/output unit can be connected; and a determination unit for determining whether the input/output unit has been connected to said input/output interface.

Examiner notes that these limitations can be interpreted in two ways according to the specification, wherein neither of the interpretations are supported by the specification.

In the first interpretation the claimed input/output unit is input/output unit describe in the specification as drive 20 and illustrated in Fig. 2. In this interpretation Examiner notes that there is no support for this input/output unit being able to capture image data from the portable recording medium and the visible recording medium. Examiner notes page 8, lines 16-25 of the specification wherein it is disclosed that the drive can input a recording medium (assumed to be a portable recording medium based on the recording medium being inserted into slot 21). Further,

Examiner notes page 15, lines 19-25 of the specification wherein it is disclosed that a printer can be connected to the USB terminal. It has not been found in the specification that the drive is able to capture image data from a visible recording medium, let alone to be able to capture image data from both a portable recording medium and a visible recording medium.

In the second interpretation the entire kiosk illustrated in Fig. 2 is the claimed input/output unit wherein there is clear support for it to capture image data from the portable recording medium and the visible recording medium through the illustrated scanner 6 and the floppy drive and memory card slots 4 and 5. Further there is clear disclosure of a hot-pluggable input/output interface to which the input/output unit can be connected through the kiosk being connected to the USB terminal 3 as illustrated in Fig. 2. As such, the kiosk can be connected to the USB terminal. However, according to this interpretation there is no disclosure of a determination unit for determining whether the input/output unit has been connected to said input/output interface. In particular, there is no disclosure for determining whether the kiosk has been connected to the USB terminal 3. Rather, it is assumed in the specification that the kiosk and USB terminal 3 are integrally formed as illustrated in Fig. 2.

The same or similar combination of limitations are present in claims 3 and 7 also. As such the above arguments apply to claims 3 and 7 as well.

Claims 2 and 4-6 are dependant on claims 1 and 3 respectively.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over (USPN 6,529,644 to Ito et al.) in view of (COMPCOM '95 to Hoffman) in further view of (US PG-PUB 20010011262 to Hoyt et al.).

In regards to claim 1 Examiner is making the assumption that the claims will be amended to coincide with Examiners first interpretation of the specification and claims. As such, the limitation "an input/output unit that is able to capture the image data from the portable recording medium and the visible recording medium" will be treated as "an input/output unit that is able to capture the image data from the portable recording medium".

In regards to claim 1 Ito discloses an image capture system having an image capture unit for capturing image data representing an image (e.g., elements 11-13, 15-17, and 80-82 of Fig. 24), a display unit for displaying the image captured by the image capture unit (e.g., element 14 of Fig. 24), and a recording control unit for executing processing for recording the image data (e.g., elements 16 and 17 of Fig. 24), which has been captured by the image capture unit, from a portable recording medium and processing for recording an image represented by the image data (e.g., the portable recording medium is the recording medium attached to input 80 of Fig. 24; column 11, lines 60-62), which has been captured by the image capture unit, from a visible recording medium (e.g., the visible recording medium is the scene captured by the camera element 11 of Fig. 24 as discussed above), said system comprising:

an output unit that is able to capture the image data from the portable recording medium (e.g., the video output device connected to the external video input terminal 80 of Fig. 24; column 11, lines 60-62);

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an input interface to which the output unit can be connected (element 80 of Figs. 24 and 26);

a command input unit for applying a use verification command which verifies use of the image capture unit (e.g., step S1 of Fig. 25; column 11, line 58 – column 12, line 56);

a determination unit for determining whether the output unit has been connected to said input interface (e.g., step S81 of Fig. 25); and

a notification unit for giving notification that input of an image by an output unit connected to said input interface is possible when the use verification command has been applied from said command input unit and said determination unit has determined that the output unit has been connected (e.g., notification is given at least in step S82 through the selection of the external video input).

Ito does not explicitly disclose nor preclude that the output unit is hot-pluggable or notification that an input/output unit can be connected to said input/output interface when said determination unit has determined that the input/output unit has not been connected.

It is extremely well known in the art to provide hot-pluggable input/output units such as the IEEE 1394 serial bus as taught by Hoffman in order to provide automatic bus configuration and topology changes so as to eliminate the need for address switches or other intervention to reconfigure the bus and further to enable transportation of both data and power as described in sections 2-4. Examiner notes that Ito discloses that the input interface, element 80, is used to input image data wherein one skilled in the art at the time of the invention would clearly recognize the advantage of using a hot-pluggable interface such as the IEEE 1394 interface with a kiosk so as to enable the connection of various devices, such as external storage for portably

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storing image data, without the need to restart the kiosk or provide additional means for enabling the use of an external device with a kiosk. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have made Ito's input interface and output unit a IEEE 1394 serial bus interface in order to provide automatic bus configuration and topology changes so as to eliminate the need for address switches or other intervention to reconfigure the bus and further to enable transportation of both data and power.

Examiner further notes that it is extremely well known in the art to provide visual instruction on the use and operation of photo-booths or kiosks as taught by Hoyt (paragraphs 0052 and 0056) in order to enable a user to know how to use the photo-booth or kiosk. As further evidence Examiner further notes the more general teaching of providing instruction to a user called scripting disclosed in US PG-PUB 2001/0056362 to Hanagan et al. in paragraph 0171 and further that this technique can be used in kiosks as disclosed in paragraph 0181. Further, USPN 5,897,220 to Huang et al. discloses that audio instructions can also be made with the video instruction (column 9, lines 41-62). Examiner further notes that Hoyt discloses an "Attract Loop" to output an audio/video presentation to demonstrate an operation and/or benefits of the present booth to attract or lure customers (paragraph 0056). As such, notification would be given that an external device can be attached when one isn't detected to be attached. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have added a notification that an input/output unit can be connected to said input/output interface when said determination unit has determined that the input/output unit has not been connected in order to provide visual instructions to the user on how to use Ito's invention as taught by Hoyt.

In regards to claim 2 note step S81 of Fig. 25 is for detection of the insertion of money.

In regards to claim 3 see Examiners notes on the rejection of claim 1.

In regards to claim 4 Ito provides means for selecting the image data through the use of a shutter button 17a wherein the image data is captured from the image capture unit if no input/output unit is attached and image data is captured from the input/output unit when one is detected to be connected (column 12, lines 5-26).

In regards to claim 5 Ito does not disclose that the notification unit gives notification that an input/output unit can be connected to said input/output interface, regardless of the use verification command given from said command input unit, when said determination unit has determined that the input/output unit has not been connected.

Examiner notes that Hoyt discloses an "Attract Loop" to output an audio/video presentation to demonstrate an operation and/or benefits of the present booth to attract or lure customers (paragraph 0056). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have added an "Attract Loop" in order to demonstrate an operation and/or benefits of the present booth to attract or lure customers. As such, one skilled in the art would recognize the clear benefit of Ito's invention enabling the input of an external video input device and therefore would also recognize to display this ability when no users are operating the photo-booth, and therefore no input/output unit would be detected, in order to lure customers to the photo-booth.

In regards to claim 6 neither Ito nor Hoyt explicitly disclose that the video display of the instructions would display a sentence of notification. One skilled in the art would clearly recognize to display pictorial as well text video information such as a sentence to a user in order to enable a most clear description of the instructions. Official notice is taken. Therefore it

would have been obvious to one skilled in the art at the time of the invention to have displayed a sentence of notification in order to enable a most clear description of the instructions.

In regards to claim 7 Examiner is making the assumption that the claims will be amended to coincide with Examiners second interpretation of the specification and claims. As such, the limitation "a determination unit for determining whether the input/output unit has been connected to said input/output interface" will be treated as "a determination unit for determining whether the portable recording medium has been connected to said input/output interface".

Ito discloses an image capture system having an image capture unit for capturing image data representing an image (e.g., elements 11-13, 15-17, and 80-82 of Fig. 24), a display unit for displaying the image captured by the image capture unit (e.g., element 14 of Fig. 24), and a recording control unit for executing processing for recording the image data (e.g., elements 16 and 17 of Fig. 24), which has been captured by the image capture unit, from a portable recording medium and processing for recording an image represented by the image data (e.g., the portable recording medium is the recording medium attached to input 80 of Fig. 24; column 11, lines 60-62), which has been captured by the image capture unit, from a visible recording medium (e.g., the visible recording medium is the scene captured by the camera element 11 of Fig. 24 as discussed above), said system comprising:

An input/output unit that is able to capture the image data from the visible recording medium (e.g., elements 12-19, 81, and 82 of Fig. 24 wherein these elements can capture image data from the camera 11);

an input interface to which the input/output unit can be connected (element 80 of Fig. 24 wherein the elements discussed above are connected to element 80);

a command input unit for applying a use verification command which verifies use of the image capture unit (e.g., step S1 of Fig. 25; column 11, line 58 – column 12, line 56);

a determination unit for determining whether the portable recording medium has been connected to said input interface (e.g., step S81 of Fig. 25); and

a notification unit for giving notification that input of an image by an output unit connected to said input interface is possible when the use verification command has been applied from said command input unit and said determination unit has determined that the output unit has been connected (e.g., notification is given at least in step S82 through the selection of the external video input).

Ito does not explicitly disclose nor preclude that the input interface is hot-pluggable or notification that an input/output unit can be connected to said input/output interface when said determination unit has determined that the input/output unit has not been connected.

It is extremely well known in the art to provide hot-pluggable input/output interface such as the IEEE 1394 serial bus as taught by Hoffman in order to provide automatic bus configuration and topology changes so as to eliminate the need for address switches or other intervention to reconfigure the bus and further to enable transportation of both data and power as described in sections 2-4. Examiner notes that Ito discloses that the input interface, element 80, is used to input image data wherein one skilled in the art at the time of the invention would clearly recognize the advantage of using a hot-pluggable interface such as the IEEE 1394 interface with a kiosk so as to enable the connection of various devices, such as external storage

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for portably storing image data, without the need to restart the kiosk or provide additional means for enabling the use of an external device with a kiosk. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have made Ito's input interface and output unit a IEEE 1394 serial bus interface in order to provide automatic bus configuration and topology changes so as to eliminate the need for address switches or other intervention to reconfigure the bus and further to enable transportation of both data and power.

Examiner further notes that it is extremely well known in the art to provide visual instruction on the use and operation of photo-booths or kiosks as taught by Hoyt (paragraphs 0052 and 0056) in order to enable a user to know how to use the photo-booth or kiosk. As further evidence Examiner further notes the more general teaching of providing instruction to a user called scripting disclosed in US PG-PUB 2001/0056362 to Hanagan et al. in paragraph 0171 and further that this technique can be used in kiosks as disclosed in paragraph 0181. Further, USPN 5,897,220 to Huang et al. discloses that audio instructions can also be made with the video instruction (column 9, lines 41-62). Examiner further notes that Hoyt discloses an "Attract Loop" to output an audio/video presentation to demonstrate an operation and/or benefits of the present booth to attract or lure customers (paragraph 0056). As such, notification would be given that an external device can be attached when one isn't detected to be attached. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have added a notification that an input/output unit can be connected to said input/output interface when said determination unit has determined that the input/output unit has not been connected in order to provide visual instructions to the user on how to use Ito's invention as taught by Hoyt.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 571-272-7364 or by fax at 571-273-7364. The examiner can normally be reached on Monday thru Friday 8:30am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached at 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 571-272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian C Genco
Examiner
Art Unit 2615

April 6, 2005


TUAN HO
PRIMARY EXAMINER